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IN THE

**Supreme Court of the United States**

**OCTOBER TERM, 1976**

**No. 532**

OWEN FINLAY MACLAREN, MIRON CHARLES BELL, GENERAL  
RECREATION, INCORPORATED and GERICO INCORPORATED,

*Petitioners,*

*v.*

B-I-W GROUP, INC. and CROSS RIVER PRODUCTS, INC.,

*Respondents.*

**BRIEF FOR RESPONDENTS IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR THE  
SECOND CIRCUIT**

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## BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

### THE QUESTIONS PRESENTED

1. When an "unexpected result" is not only unclaimed by the inventor but also nowhere described or alluded to in his patent specification, can that not only "unexpected" but, so far as appears, unperceived result be relied upon for patentability?

2. When the claimed combination which gives rise to the "unexpected result" was "obvious," can that "unexpected result" be relied upon for patentability?

The Second Circuit correctly answered both questions in the negative.

## STATEMENT OF THE CASE

Petitioners' "Question Presented" is not in fact raised by the unanimous decision of the Court of Appeals.\*

The Petition rests entirely on the assertion that the Second Circuit's invalidation of the Maclaren patent depends on its determination that the "simultaneous-folding" feature of the Maclaren stroller was not set forth in the claims. The Court of Appeals is said to have made "new law" by ruling that "it is not sufficient for the elements of the combination which produce the unexpected result to be recited, but the result itself must be specifically set forth in the claim." (Petition, p. 10)

Throughout the Petition, the Court of Appeals' alleged imposition of this requirement is repeatedly represented to have constituted the sole basis of that Court's decision. For example, the Petitioners, after discussing the District Court's finding that the Maclaren stroller achieved the "unexpected" end result of simultaneous folding, go on to narrow the Court of Appeals' holding to Petitioners' alleged basis, as follows:

"The Court of Appeals never disputed the District Court's finding, but merely stated that the District Court was in error to rely on an end result not set forth in the claims. (See 55a)." (Petition, p. 8)

Petitioners' "Statement of the Case" in this way is woefully misleading because it tells only half of the story. The Court of Appeals did not base its holding of invalidity

\* The opinion of Circuit Judge Mansfield was joined in by Circuit Judges Friendly and Mulligan, and the petitions for rehearing and rehearing *in banc* were unanimously denied by the Court. (Appendix, pp. 62a-65a)

simply on the ground that "simultaneous folding" was omitted from the claims (as, of course, it was). The Court of Appeals also based its decision on the further grounds that "simultaneous folding" was *not even described* in the Maclaren patent specification and that, to the contrary, the patent indicated that the Maclaren stroller exhibited *non-simultaneous* folding:

"This novel feature of simultaneous folding, however, is nowhere *mentioned*, much less claimed, in the Maclaren patent. Its claims, while describing in detail the essential features of the collapsible support structure, make no reference, express or implied, to simultaneous folding. *Nor do the specifications describe any such feature.*" (Emphasis added.) (Appendix pp. 48a-49a)

". . . Even if we went further and treated the two paragraphs of the specifications as part of the claims, they would not suggest simultaneous folding. On the contrary, the statement is made that '*Continued folding, beyond the condition dotted in FIGURE 2, although possible in theory by continuing to bring the handles 7D, 8D together, is in fact not practicable, so the user assists folding by directly raising the forward end of the structure (or pressing down the handles toward the ground) until the folded condition of FIGURE 3 is reached.*' (Emphasis added) (E82). This language seems to point to the opposite conclusion, indicating that at least two steps are required to collapse the structure." (Emphasis in original.) (Appendix, p. 49a)

Thus, the Court of Appeals did not in fact refuse to predicate patentability on the "simultaneous-folding" feature simply because this "end result" was omitted from the claims; rather, the Court refused to predicate patentability



on the feature because the patent not only did not describe it but, if anything, affirmatively disclaimed it.\*

The Second Circuit's holding, based as it was on factual findings, does not raise the "Question Presented" by Petitioners and in no way conflicts with any prior ruling of this Court.

## REASONS FOR DENYING THE WRIT

### THE DECISION BELOW IS CLEARLY CORRECT

#### (1) The Second Circuit's Actual, As Opposed To The Alleged, Holding On Simultaneous Folding Is Clearly Consistent With Prior Decisions Of This Court

As has been shown, the Court of Appeals' decision did not rest on the determination, as a matter of law, that an "end result" must be specifically mentioned in a claim if it is to be relied upon for patentability. It rested, in fact, on the critical, factual determinations that the "end result" which is the crux of the Petition is not even mentioned in the patent description and that, on the contrary, the patent description suggests, if anything, that the feature does not even exist.

It has long been recognized that an unclaimed feature which is not even described in a patent specification cannot be relied upon for patentability. This Court considered this

\* The emphasis in this "Statement" section of our Brief is on the simultaneous-folding feature only because its purported mis-treatment by the Court of Appeals constitutes the sole basis of the Petition. But this Court should be aware that the Second Circuit's ruling on invalidity was also founded on the usual "obviousness" considerations under 35 U.S.C. § 103. The District Court found that "there was nothing new about the individual elements of the Maclaren invention." (Appendix, p. 21a) The Court of Appeals carried this one step further and found that to *combine* the old individual elements was also "obvious." (Appendix, pp. 51a-57a) See pp. 6-8, *infra*.

issue, for example, in *Graham v. John Deere Co.*, 383 U.S. 1, 25 (1966):

"Petitioners' argument basing validity on the free-flex theory raised for the first time on appeal is reminiscent of *Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp.*, 303 U.S. 545, 58 S.Ct. 662, 82 L.Ed. 1008 (1938), where the Court called such an effort 'an after-thought. No such function . . . is hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus, it is strange that all mention of it was omitted.' At p. 550, 68 S.Ct. at p. 665. No 'flexing' argument was raised in the Patent Office. Indeed, the trial judge specifically found that 'flexing is not a claim of the patent in suit . . .' and would not permit interrogation as to flexing in the accused devices."

See also, *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 58-60 (1938), and *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 57-58 (1931).

Of the several cases cited by Petitioners, only one, *United States v. Adams*, 383 U.S. 39 (1966), bears at all on the question whether an unexpected result must be recited in a patent claim in order for it to be relied upon for patentability. That case actually supports the result reached by the Court of Appeals and was cited by it. (Appendix, p. 46a) As set forth in the Petition, at page 10, the "surprising results" of the Adams battery were that it was water-activatable and produced a constant potential. This Court began its discussion of the Adams invention by noting that the Adams patent specification clearly stated that the objects of the invention were to provide a water-activatable, constant-potential battery. *Id.* at 42. Had the Adams description not emphasized these objects, the Adams

patent clearly would not have passed muster. *Id.* at 48-49. *Cf. Graham*, p. 5, *supra*. How different is the present case in which the patent specification not only fails to mention a "surprising" simultaneous folding but concedes that the stroller is *non-simultaneous* folding. Thus, Petitioners' failure to mention the negation of an "end result" in the Maclaren specification is compounded by their failure to mention this Court's emphasis on the presence of a description of the "end result" in the Adams specification.

**(2) The Second Circuit's Judgment Is In Any Event Supported By Its Further Holding That The Combination Which Gives Rise To Simultaneous Folding Was Obvious**

The Court of Appeals treated the claims as though they did not embrace the feature of simultaneous folding—for good reason, since the patent itself suggests otherwise. But even if the Court of Appeals had considered the claims to embrace the feature, it would have made no difference in result; the Court of Appeals held that the claimed combination, the combination giving rise to the "end result" in issue, was itself "obvious."\*

Petitioners argue (Petition, p. 6) that the elements of claim 10 (seat struts 12A, 12B, and knuckle joints 7B, 8B) produce simultaneous folding. But the Court of Appeals, in footnote 20 (Appendix, p. 60a), specifically held that the Hurvitz prior art patent contained a seat strut/knuckle joint design "that is essentially identical to Maclaren's,"

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\* It is not accurate for Petitioners to imply that the Court of Appeals based its "obviousness" finding on a single 103-year old Turner patent (Petition, p. 9), when the Court analyzed in detail four prior art patents and found that (1) every feature in Maclaren claim 1 was shown in at least two of the prior art patents, and (2) it would have been "obvious" to combine the claimed prior art features. (Appendix, pp. 54a-60a)

and that Maclaren's "use of a knuckle joint and seat strut probably cannot qualify as a novel, let alone a non-obvious, improvement over the art."

The Court of Appeals' "obviousness" finding with respect to claim 10 completely undermines the purported basis for the Petition.

The "Question Presented" by Petitioners (Petition, p. 2) is based upon the factual premise that the patent claim defines something "not obvious to those skilled in the art." But that factual premise is itself inconsistent with the decision of the Court of Appeals. For this Court even to reach Petitioners' purported "legal" issue would, therefore, first require determinations by this Court not only that (1) the Court of Appeals erred in its conclusion that the Maclaren patent did not describe the simultaneous-folding feature, but also that (2) the Court of Appeals erred in its finding that the claimed combination was obvious. But as this Court has held, "[w]here the questions presented by the contested claims of infringement and validity are purely factual, this Court ordinarily accepts the concurrent conclusions of the district court [\*] and Circuit Court of Appeals in these cases." *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 473 (1944).

Perhaps Petitioners did not wish to alert this Court to the fact that a grant of their Petition would require a detailed analysis of numerous prior art patents and the reversal of the Court of Appeals on threshold technical,

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\* While the district court in the present case held that the claimed combination was not obvious and simultaneous folding was a novel feature, in a complete contradiction it also found as a fact that "[s]imultaneous folding in two dimensions was also known in strollers as indicated by [the prior art patents of] Shibasaki and Tailland." (Appendix, p. 22a)

factual questions. But that is hardly an excuse for framing the "Question Presented" with a premise ("non-obviousness") that is in conflict with the findings of the Court of Appeals.

**THERE IS NEITHER A CONFLICT OF DECISIONAL LAW  
NOR AN IMPORTANT QUESTION OF FEDERAL LAW**

Petitioners argue (Petition, p. 10) that the Court of Appeals "has added still further requirements to the Supreme Court test for compliance with 35 U.S.C. 103," and that "[t]here is a broad public interest here which goes much beyond the present parties." But the Court of Appeals meticulously followed the guidelines of this Court; it did not "add" a requirement to this Court's "test" under 35 U.S.C. § 103, but simply held that the test was not met. And the only "public interest" conceivably involved here is that of those who might wish to change the "obviousness" test as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), a decision which has been consistently hailed by both the lower courts and the patent bar for its logic and cogency.

**CONCLUSION**

For the foregoing reasons, it is respectfully submitted that the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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